

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed April 13, 2009. Currently, claims 1-4, 6, 8-14, 16, 18-25, and 27-36 remain pending. Claims 1-4, 6, 8-14, 16, 18-25, and 27-36 have been rejected. The claims have been amended to clarify the relationships among the elements. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 1-4, 6, 8-11, 22, 25, and 27-36 were rejected under 35 U.S.C. 102(b) as anticipated by Vale et al. (U.S. Published Patent Application No. 2002/0058963), hereinafter Vale. After careful review, Applicant must respectfully traverse this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131). Nowhere does Vale appear to teach or suggest:

wherein the dilator tip has a first position inserted at least in part within the distal segment of the elongated tubular member such that the distal segment expands around at least a portion of the proximal section of the dilator tip and the raised ridge is adjacent the distal end of the distal segment, further wherein subsequent contact between the dilator tip and a medical device to be retrieved urges the dilator tip to assume a second position entirely within the elongated tubular member and proximal of at least a portion of the medical device positioned within the distal segment, as recited in claim 1 and in related language in independent claims 12, 22, and 31-33.

Instead, Vale appears to teach a retrieval catheter (73) for an embolic filter having a proximal extension. The cited Figures 27-30 do not appear to include an elongated member having a separate distal tip element insertable within the distal end of the retrieval catheter. The proximal section of the filter to be retrieved does not appear to constitute a separate element having the characteristics of the claimed distal tip for at least the reasons that it does not appear to have a generally constant diameter proximal

section such that the distal segment expands around at least a portion of the proximal section of the dilator tip in a first position when the raised ridge is adjacent the distal end of the distal segment; that the proximal section of the filter does not appear to be disclosed to have an inner lumen disposed therethrough; that the portion of the filter distal of the identified “ridge”, the distal section, does not appear to taper distally, but rather expands distally until it joins the filter; that the portion of the filter identified as the “distal section” is also identified the filter to be retrieved; and that the integral “distal section” of the filter (71) does not appear to be capable of “subsequent contact” with the filter to be retrieved of which it is an integral part.

For at least these reasons, Vale does not appear to disclose *each and every element as set forth in the claim*, as found in each of independent claims 1, 12, 22, 31, 32, and 33 and Applicants respectfully request that the rejections be withdrawn.

Additionally, for similar reasons as well as others, claims 2-4, 6, 8-11, 25, 27-31, and 34-36 which depend from claims 1, 22, and 33 respectively, and include significant additional limitations, are believed to be not anticipated by Vale and Applicants respectfully request that the rejections be withdrawn.

Claim Rejections – 35 USC § 103

Claims 2 and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vale in view of Nilsson et al. (U.S. Patent No. 5,873,851), hereinafter Nilsson. After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). As discussed previously, nowhere does Vale appear to disclose all elements of claims 1 and 22 as is required to establish a *prima facie* case of obviousness. Furthermore, nowhere does Nilsson, said to teach a proximal segment of the tubular member varies in thickness along its length, appear to remedy the shortcomings of Vale. Therefore, Vale in view of Nilsson does not appear to teach all the

claim limitations found in independent claims 1 and 22, as is required to establish a *prima facie* case of obviousness.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, Applicants believe that claims 2 and 23, which depend from nonobvious independent claims 1 and 22 respectively, are also nonobvious and respectfully request that the rejections be withdrawn.

Claims 3, 12, 14, 16, 18-21, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vale in view of Salahieh et al. (U.S. Published Patent Application No. 2002/0127936), hereinafter Salahieh. After careful review, Applicant must respectfully traverse this rejection.

As discussed previously, nowhere does Vale appear to disclose all elements of claims 1 and 22 as is required to establish a *prima facie* case of obviousness. Salahieh, said to teach a braid in the distal segment, does not appear to remedy the shortcomings of Vale. Therefore, Vale in view of Salahieh does not appear to teach all the claim limitations found in independent claims 1 and 22, as is required to establish a *prima facie* case of obviousness. Similarly, Salahieh does not appear to overcome the deficiencies of Vale as applied to claim 12 discussed above.

Accordingly, Applicants believe that claims 3, 14, 16, 18, 21, and 24, which depend from nonobvious claims 1, 12, and 22, are nonobvious and respectfully request that the rejections be withdrawn.

Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Vale in view of Salahieh as applied to claim 12, and in further view of Nilsson. After careful review, Applicant must respectfully traverse this rejection.

Claim 12 has been shown to be nonobvious over Vale in view of Salahieh as applied to claim 12. Vail, said to teach a tubular member can have varying thickness, does not appear to overcome the deficiencies of Vale in view of Salahieh as applied to

independent claim 12 discussed above. Therefore, Vale in view of Salahieh and further in view of Nilsson does not appear to teach all the claim limitations found in independent claim 12, as is required to establish a *prima facie* case of obviousness.

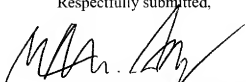
Accordingly, Applicants believe that claim 13, which depends from nonobvious independent claim 12, is also nonobvious and respectfully request that the rejection be withdrawn.

In the Response to Arguments, the Examiner repeats the assertion that the filter of Vale, the medical device retrieved by Vale, also provides the elements of the separate distal tip of the independent claims. As amended, the claims are believed to require that the distal tip have properties incompatible with the proximal portion of the filter/medical device of Vale to be retrieved. In addition, the distal tip of the pending claims is an element of the claims distinct from the filter/medical device to be retrieved.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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